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In re Application of
GRAY
Application No.: 09/486,183
PCT No.: PCT/GB00/00286
Int. Filing Date: 02 February 2000
Priority Date: 08 February 1999
Attorney's Docket No.: 540-188
For: FIBRE REINFORCED COMPOSITES AND
METHODS OF MAKING SAME

DECISION ON
PETITION
UNDER 37 CFR 1.181

This is in response to the "Request for Reconsideration of Prior Decision Denying Petition to the Commissioner under 37 CFR 1.181" filed 14 May 2003. The original petition under 37 CFR 1.181, filed 26 February 2003, requesting examination of claims 1-13 as originally filed in the above-identified international application, was dismissed in a decision dated 11 April 2003. For the reasons set forth below, the renewed petition is granted to the extent so indicated.

BACKGROUND

On 02 February 2000, applicant filed international application PCT/GB00/00286 in the English language, which claimed priority of an earlier British application filed 08 February 1999.

On 23 February 2000, applicant filed with the United States Patent and Trademark Office (USPTO) a transmittal letter for entry into the national stage in the United States, which was accompanied by, inter alia, the requisite basic national fee as required by 35 U.S.C. 371(c)(1); and a declaration as required by 35 U.S.C. 371(c)(4). The payment of the basic national fee was prior to midnight on 08 August 2001, the thirty-month period for paying the basic national fee in the United States. The transmittal letter indicated that the copy of the international application had been transmitted by the International Bureau.

On 13 July 2000, applicants filed a Status Inquiry with the United States Patent and Trademark Office requesting when an Official Filing Receipt would be issued.

On 17 August 2000, a copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau.

On 19 August 2000, applicant filed with the European Patent Office a Demand for international preliminary examination, in which the United States was elected, prior to the expiration of nineteen months from the priority date.

On 23 August 2000, applicant filed with the USPTO, a copy of the Request (Form PCT/RO/101).

On 26 January 2001, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration of the inventors had not been filed. The notification set a one-month time limit in which to respond.

On 07 February 2001, applicant filed a response to the Notification of Missing Requirements indicating that the declaration had been filed on 23 February 2000.

On 12 February 2001, applicant filed with the European Patent Office amendments to the international application under PCT Article 34 amending sheet one of the description and the claims. The claims were amended by substituting new claims 1-11 for original claims 1-13.

On 09 May 2001, the European Patent Office established an international preliminary examination report (IPER) based on replacement sheets 1 and 1a and amended claims 1-11 and attached the amended sheets as annexes to the IPER.

On 11 September 2001, the United States Designated/Elected Office mailed a Notification of Acceptance of Application under 35 U.S.C. 371 and 37 CFR 1.494 or 1.495 (Form PCT/DO/EO/903) indicating the annexes to the IPER had been entered. On 21 September 2001, the USPTO mailed an Official Filing Receipt indicating the application contained a total of 13 claims.

On 20 May 2002, the USPTO mailed a first Office action based on an examination of the claims contained in the annexes, i.e. claims 1-11.

On 20 November 2002, applicant filed a response to the first Office action indicating that the Office action did not act on original claims 1-13.

On 18 December 2002, the USPTO issued a final office action on claims 1-11 indicating that the claims 1-11 were properly before the examiner for examination.

On 26 February 2003, applicant filed a petition requesting that original claims 1-13 be examined.

On 11 April 2003, applicant's petition was dismissed. The petition concluded that amended claims 1-11 had been properly examined by the USPTO.

On 14 May 2003, applicant filed the present request for reconsideration of the decision on petition.

On 18 June 2003, applicant filed a notice of appeal of the rejected claims.

DISCUSSION

Applicant's arguments that the petition filed on 26 February 2003 was filed timely are accepted. Although the Notice of Acceptance mailed on 11 September 2001 indicated that the annexes to the IPER were entered, the Notice did not indicate a completion date of all requirements under 35 U.S.C. 371 later than the original submission date of 23 February 2000. The indication of a completion date of all requirements under 35 U.S.C. 371 of 23 February 2000 and that the annexes to the IPER were entered are internally inconsistent indications. Furthermore, as applicant has correctly pointed out, with the entry of the amended claims 1-11, the Official Filing Receipt should have indicated 11 claims present, instead of indicating 13 claims present. Because of the conflicting information, it does not appear that applicant learned of the entry of the annexes (claims 1-11) until the first Office action mailed 20 May 2002.

Applicant has put forth the argument that the national stage application was ready for examination on February 23, 2000 and therefore no amendments communicated by WIPO after that date should be considered. Relevant portions of 35 U.S.C. 371 are reproduced below.

"(a) Receipt from the International Bureau of copies of international applications with any amendments to the claims, international search reports, and international preliminary examination reports including any annexes thereto may be required in the case of international applications designating or electing the United States.

(b) Subject to subsection (f) of this section, the national stage shall commence with the expiration of the applicable time limit under article 22 (1) or (2), or under article 39 (1)(a) of the treaty.

(f) At the express request of the applicant, the national stage of processing may be commenced at any time at which the application is in order for such

purpose and the applicable requirements of subsection (c) of this section have been complied with."

Subsection (a) clearly gives the Director the authority to require the international preliminary examination report including any annexes thereto to be communicated to the USPTO in any national stage application.

Subsection (b) establishes that the national stage shall commence 30 months from the priority date of the international application. However, the time limit in this subsection is not applicable if the applicant requests that national stage processing commence at an earlier time, in accordance with subsection (f).

Subsection (f) provides that the national stage of processing the application may begin at any earlier time if expressly requested by the applicant and if the application is otherwise in order for processing in the national stage (i.e., the applicant must have complied with the applicable requirements of 35 U.S.C. 371(c)).

In the instant application, applicant requested early processing of the national stage on 23 February 2000. On the same date he filed the requisite basic national fee as required by 35 U.S.C. 371(c)(1) and a declaration as required by 35 U.S.C. 371(c)(4). A further review of the file reveals that a copy of the international application was not filed on 23 February 2000. This fact is confirmed by the copy of the post card received by the USPTO on 23 February 2000 presented with the paper filed on 07 February 2001. The post card indicates that a declaration, assignment and a check in the amount of \$1010.00 were filed on 23 February 2000. Thus the requirement under 35 U.S.C. 371(c)(2) for a copy of the international application was not complied with until 17 August 2000. Since there were no amendments filed on 17 August 2000 under either Article 19 or Article 34, neither 35 U.S.C. 371(c)(3) or (c)(4) were applicable as of 17 August 2000. Accordingly, since all the applicable requirements of 35 U.S.C. 371(c) had been complied with on 17 August 2000, the application was ready for examination and could have been forwarded to the Technology Center for examination. Accordingly, the previous decision dated 20 May 2003 is vacated.

Analysis of Claims

A review of original claims 1-13 and amended claims 1-11 reveals that claim 1 was amended to include the limitation of original claim 2. Original claims 3-12 were renumbered as claims 2-11. Original claim 13 reads, "An aircraft containing a composite produced according to the method of any of claims 1 to 9." Original claim 12 reads, "An aircraft aerofoil incorporating a composite structural member according to claim 10 or 11." Amended claims 1, 2 and 4 were rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Vane. Additionally, amended claims 1, 2 and 4 were rejected under 35 U.S.C. 103(a) as being unpatentable over Vane in view of any

one of Kalnin, Durand et al of Gorhala et al. Amended claims 3 was rejected under 35 U.S.C. 103(a) as being unpatentable over the reference cited in the rejection of claims 1, 2 and 4 in view of any one of Yokota et al or Street. Since amended claim 1 contains limitations not found in original claim 1, original claims 1-5 would be subject to the same rejection as amended claims 1-4. Amended claims 5-11 were objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from another multiple dependent claim. Original claims 6-11 would be subject to the same objection. Additionally, since an aircraft airfoil is a part of an aircraft, amended claim 11 would fall within the scope of original claim 13. Furthermore, the failure to treat original claim 13 on the merits is harmless error, since it is an improper multiple dependent claim which would not have been treated on the merits. It is also noted that applicant has made no attempt to cure the improper multiple dependency of either the original of the amended claims. Since the rejection of amended claims 1-4 also applies to original claims 1-5 any error on the part of the Office can be viewed as harmless error as the applicant's right to appeal the patentability of those claims will not be prejudiced if such claims are submitted for purposes of appeal.

In view of applicant's notice of appeal of the rejection of the amended claims and that the original claims are broader than the claims currently under rejection, the examiner's rejection equally applies to the original claims. In view of applicant's notice of appeal which indicates applicant's desire to have the claims reviewed by the USPTO's Board of Patent Appeals and Interferences, applicant will be permitted after Final Rejection to insert the original claims as a matter of right for the purpose of appeal and applicant may appeal both sets of claims. Any other amendment that may require further consideration or search may be denied entry by the examiner.

CONCLUSION

The renewed petition under 37 CFR 1.181 is GRANTED to the extent indicated above.

This application is being returned to the National Stage Processing for the mailing of a corrected Notice of Acceptance (Form DO/EO/903) indicating a 371(c)(1), (c)(2) and (c)(4) date of 17 August 2000. Thereafter a Official Filing Receipt will be issued indicated in the "filing date" box a date of 17 August 2000 and a total of 11 claims. Finally, this application will be returned to the Technology Center awaiting applicant's appeal.



Stephen G. Kunin
Deputy Commissioner for
Patent Examination Policy

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